



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/324,182	06/02/99	SHAH	A 2870/155

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HM12/0223

EXAMINER

PULLIAM, A

ART UNIT	PAPER NUMBER
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1615

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DATE MAILED:

02/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/324,182

Applicant(s)

SHAH ET AL.

Examiner

Amy E Pulliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the Amendment A and the Supplemental Information Disclosure Statement, both received January 5, 2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-19, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,523,091 to Pastour *et al.* (hereinafter Pastour). Pastour discloses a cosmetic emulsion composition which comprises a silicone, a gelling agent, and an emulsifying agent (abstract). Pastour teaches that the emulsifying agent can be dimethicone and mixtures thereof (c 1, l 45). Pastour further teaches that the silicone can be a cyclomethicone (c 3, l 18). Pastour also allows for additives such as vegetable oils such as jojoba oil, apricot oil, grape seed oil, and others (c 5, l 1-13), and he also includes surfactants (c 5, l 20), and pigments (c 5, l 44). Pastour also teaches that the composition can comprise active ingredients such as plant extracts, and these can be present from between 1 and 15%. Further, the cosmetic can contain fillers of plants, either inorganic or synthetic, such as starch or nylon (c 6, l 3-11). Lastly, Pastour teaches that his composition can be in the form of a mascara.

Applicant's arguments have been fully considered but are not found persuasive. Applicant argues that the teaching in Pastour of 1-15 % active ingredients is referring to the active principles derived from the plant extracts, rather than the actual plant extracts. However, the examiner disagrees. Column 6, lines 3-7 of the reference clearly states that the composition... " can comprise active ingredients such as plant extracts.... These active ingredients are then present... between 1 and 15%." This teachings states that the plant extract *is* the active ingredient, and therefore supports the examiner's position.

Additionally, applicant argues that the reference does not teach a seedless but substantially unfiltered extract. However, nowhere in the reference does it state that the extract must be filtered. Again, the examiner relies on the above citation which allows for the inclusion of plant extracts, with no requirement for filtration.

Furthermore, it is unclear to the examiner what is unexpected about applicant's claimed product. It is the position of the examiner that there is no functional difference between applicant's claimed mascara and the mascara disclosed by Pastour. Additionally, applicant has demonstrated no unexpected results. Specifically, on page 8 of applicant's specification, there is a discussion of a study using the claimed formulation. For each of the tested characteristics (natural appearance, comfort on the lashes, not causing lashes to be pointed, lack of clumping), 80% of the women said the mascara was equal to or better than their current mascara. This data can be interpreted to mean that 80% or more of the women thought the claimed formulation performed the

same as the current formulation, therefore rendering no unexpected results. Therefore, the above rejections are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,523,091 to Pastour *et al.*. Pastour is discussed above as disclosing a cosmetic composition, which can be a mascara, and which can contain actives such as plant extracts. Pastour does not teach the specific percent of extract as claimed in claim 3. However, he does teach a very small and similar amount of extract. Further, Pastour does not teach the specific natural non-plant fiber as claimed by applicant. However, he does teach the inclusion of inorganic and synthetic fillers in general. Pastour does not teach the specific surfactant as claimed by applicant. It is the position of the examiner that the exact percent of the extract, the specific inorganic additives, and the specific surfactant are all limitations which would be routinely determined by one of ordinary skill in the art, as being suitable, based on the generic teachings in Pastour. Furthermore, the examiner reads the teaching of plant extract to include any and all plants, as Pastour does not differentiate. Therefore, this teaching includes both vegetables and fruits. One of ordinary skill in the art would have been motivated to make a mascara

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composition based on Pastour's teachings, which comprises any plant extract, and also contains inorganic or synthetic fillers and surfactants. The expected result would be a successful mascara composition, which has the beneficial qualities of Pastour's composition, which are ease of application, softness, uniformity, hold, and good sensory qualities. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments have been considered but are not found persuasive for the reasons stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7922 for regular communications and (703) 308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Amy E. Pulliam
Patent Examiner
Art Unit 1615
February 22, 2001

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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